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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,376	12/04/2003	Win L. Chiou	14123.4US01	6931
7590 11/02/2006			EXAMINER	
Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			HUI, SAN MING R	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,376

Applicant(s)

CHIOU, WIN L.

Examiner

San-ming Hui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006 and 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2 11 06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments filed July 28, 2006 and August 3, 2006 have been entered. Claims 19-39 are pending.

The outstanding rejections under 35 USC 103(a) and 102(b) are withdrawn in view of the amendments filed August 3, 2006. The claims are no longer reciting the compounds taught in the cited prior arts.

The outstanding rejection under 35 USC 112, first paragraph with regard to the scope of enablement rejection is withdrawn in view of the amendments filed August 3, 2006 since the claims are now directed to the specific polyvalent metal compounds as recited in the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the instant case, the instant specification does not provide sufficient support and guidance to enable one of skilled in the art to prevent scar formation per se. It is known that the formation of scar can be contributed from various etiologies. The

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instant specification does not even discuss those situation where scar is formed due to burns victims, surgical scars, etc. It is not known in the instant specification how the salts as herein claimed would be able to prevent all kinds of scars. No mechanism of action is discussed in the instant specification. No working examples is provided. Only treatment of various skin disorders is provided in the instant specification. Examiner notes that those examples are not directed to the prevention of scars.

Response to Arguments

Applicant's arguments filed July 28, 2006 averring the prevention of scars as enabled have been fully considered but they are not persuasive. Examiner notes that "prevention" can be construed as absolute prevention. Applicant's arguments and data clearly show that scar is formed, although rapidly sloughed off (See applicant's arguments filed July 28, 2006, page 5). Therefore, prevention is not seen to be enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression "suitable dosage forms" recited in the claim renders the claim indefinite as to what the meaning of "suitable" may be encompassed by the claim. It is not clear what dosage is considered to be suitable for the treatment.

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Examiner will favorably consider the recitation of "pharmaceutically acceptable dosage forms".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 22, 31-33, and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,898,037 ('037).

'037 teaches magnesium sulfate, in the concentration of 0.1-50%, as useful in a method of topically treating acne (See col. 5, lines 52-56).

Claims 19, 21, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,053,630 ('630).

'630 teaches aluminum chelates as useful in treating acne. Aluminum chloride, and aluminum zinc sulphate are taught to form chelates as useful in the method of treating acne. It further teaches that the weight ratios of the chelates or the aluminum compounds are within the weight ratio taught (see the abstract, Col. 3, line 60 bridging to col. 4, line 12, also col. 6, Examples 21 and 24).

Claims 23, 25, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,224,339 ('339).

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'339 teaches aluminum chelates as useful in a method of treating warts.

Aluminum chloride, and aluminum zinc sulphate are taught to form chelates as useful in the method of treating acne. It further teaches that the weight ratios of the chelates or the aluminum compounds are within the weight ratio taught (see the abstract, Col. 1, lines 4-8, col. 3, lines 9-17, also, col. 5, Examples 9 and 10).

Claims 23, 24, 26, 31-33, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,371,107 ('107).

'107 teaches a 1% magnesium stearate containing composition for treating warts topically (See claim 8, also col. 3, lines 20 and 49, for example).

Claims 19, 21, 22, 27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,667,790 ('790).

'790 teaches a method of treating rosacea and acne with topical administration of aluminum halide salt such $\text{AlCl}_3 \cdot 6\text{H}_2\text{O}$, in the concentration of up to 50% (See the abstract).

Claims 27, 28, 30-33, 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,851,556 ('556).

'556 teaches a method of treating rosacea using alkaline earth metal salts in the concentration of 0.5 to 10% (See col. 7, lines 18-23 and 40-47). Magnesium chloride

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sulphat and acetate are among the preferred salts in the rosacea treatment method
(See Col. 6, lines 32-35).

Claims 31-36 are rejected under 35 U.S.C. 102(b) as being anticipated by US
6,372,784 ('784).

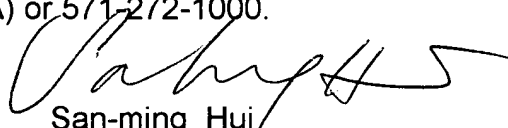
'784 teaches bismuth subcitrate, in the concentration of about at least 10%
(100mg/ml) as useful in wound healing and treatment of acne (See col. 19, lines 19-46).

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to San-ming Hui whose telephone number is (571) 272-
0626. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to
6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax
phone number for the organization where this application or proceeding is assigned is
571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



San-ming Hui
Primary Examiner
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